Dkt. 2271/62705

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Yuichi YAMAGAMI, et al.

Serial No. : Group Art Unit:

Date Filed : Concurrently Herewith Examiner:

For : MANAGING SHIPMENT CHARGES FOR INTERNATIONAL TRANSPORTATION OF ITEMS

#9
4-14-01

1185 Avenue of the Americas
New York, N.Y. 10036

Assistant Commissioner for Patents
Box Patent Application
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Sir:

The press release cited in the attached Form PTO-1449 relates to the international shipment method described at pages 1 and 2 of this patent application. As stated in the application, it has been in use by the assignee hereof (with an UPS entity) for more than a year before the filing date of this patent application to supply customers in the U.S.A. The subject matter claimed in this application also has been used for more than a year, including in this country, but internally, within the company, for private purposes such as internal accounting that produces information for internal use. The profit/loss from the method and system claimed in this application has been included in the Gross Profit in the annual report of the assignee for more than a year, without publishing the claimed subject matter. Accordingly, it is submitted that this internal use did not cause a loss of right to patent under 35 U.S.C. §102.

In *Moleculon Res. Corp. v. CBS, Inc.*, 739 F.2d 1261 (Fed. Cir. 1986), internal use for more than a year did not result in loss of rights. The inventor had demonstrated the claimed invention (a puzzle cube) to colleagues and to his employer and had used it for more than a

year before his filing date, but the court held that this did not invalidate the patent.

It is accepted that machines and processes that were used in this country to produce goods or services placed on sale in this country more than a year before the filing date preclude patentability even when such use was in secret. *Metallizing Eng'r Co. v. Kenyon B.&A. Parts Co.*, 153 F.2d 516 (2d Cir. 1946); *Woodland Trust v. Flowertree Nursery Inc.*, 148 F.3d 1368 (Fed. Cir. 1998); *Kinzenbaw v. Deere & Co.*, 741 F.2d 383 (Fed Cir. 1984). However, in the case of this application the claimed invention did not produce goods or services placed on sale, as its product was used internally. The *Metallizing* court did not consider use for "private purposes" to be a bar to patentability:

> It is indeed true that an inventor may continue for more than a year to practice his invention for his private purposes or his enjoyment and later patent it. But that is, properly construed, not an exception to the doctrine, for he is not then making use of his secret to gain a competitive advantage over others; he does not thereby extend the period of his monopoly.

Metallizing, 153 F.2d at 520.

Accordingly, it is submitted that the internal use of the claimed subject matter for more than a year is not prior art or activity that bars patentability.

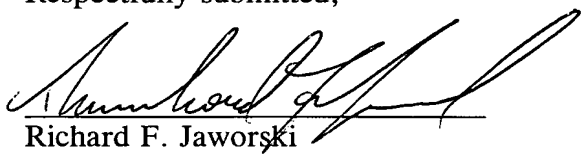
The filing of this Information Disclosure Statement is not an admission that the information cited herein is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b).

This Information Disclosure Statement is being filed concurrently with this application.

The Office is hereby authorized to charge any fees that may be required for consideration of this Information Disclosure Statement and to credit any overpayment to our Deposit Account No. 03-3125.

Early and favorable consideration of the case is respectfully requested.

Respectfully submitted,



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